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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,323	09/18/2003	David J. Payne	08049.0933	6243
22852	7590	09/18/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER JOSEPH, TONYA S	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 09/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,323

Applicant(s)

PAYNE ET AL.

Examiner

TONYA JOSEPH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-13, 16-25, 28-37 and 40-56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-13, 16-25, 28-37 and 40-56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/24/2008 has been entered.

Status of Claims

2. Claims 1, 4-13, 16-25, 28-37 and 40-56 were previously examined. No claims have been cancelled. Claims 1, 4, 6-7, 13, 16, 18-19, 25, 28, 30-31, 37, 40 and 42-43 have been amended. No claims have been added. Thus claims 1, 4-13, 16-25, 28-37 and 40-56 are presented for examination.

Response to Arguments

3. Applicant's arguments filed 06/24/2008 have been fully considered but are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 13, 16-24 and 51-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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6. Claims 13 and 51-52 recites various limitations regarding components. Software *per se* is not one of the recognized statutory classes of invention, as such, the claimed invention as it is currently presented fails to meet the requirements under 35 U.S.C 101.
7. Claims 16-24 contain the same deficiencies through dependency and as such, are rejected for the same reasons.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4-13, 16-25, 28-37 and 40-49, 51, 53 and 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. U.S. Patent No. 5,422,821 in view of Anchor (Reference U of the PTO-892).
10. As per Claims 1, 13, 25 and 37, Allen teaches receiving a second instance of an incorrect address associated with a second item (see Col. 4 lines 62-68 and Col. 5 lines 1-10, Examiner is interpreting the previously stored instance of the resolved address as a first instance and the current resolution process as the second instance. Examiner is further interpreting a second item as the physical mailpiece); comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address (see Col. 15 lines 63-68 and Col. 16 lines 1-3); and outputting the correct address from the database based on the determination (see Col. 9 lines 25-30).

Allen does not explicitly teach the limitation taught by Anchor receiving a first instance of an incorrect address to determine a correct address (see pg. 2 para. 7, Examiner is interpreting Anchor receiving a customer's list needing to be processed for corrections as receiving a first instance of an incorrect address); resolving the first instance of the incorrect address by using at least one of a plurality of address resolution processes (see pg. 2 para. 7), storing a resolved address in a database (see pg. 2 para. 7-8); the resolved address comprising the correct address and the first instance of the incorrect address record (see pg. 2 para. 7-8). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Allen to include the teachings of Anchor to maintain correct address mailing lists. Furthermore, a mere re-arrangement of parts does not distinguish itself from the prior art unless a new and unexpected result is found.

11. As per Claims 4, 16, 28 and 40, Allen in view of Anchor teaches the method, medium and system of claims 1, 25 and 37 as described above. Allen further teaches processing the second item for delivery in an item delivery system (see Col. 5 lines 1-10).

12. As per Claims 5, 17, 29 and 41, Allen in view of Anchor teaches the method, medium and system of claims 4, 28 and 40 as described above. Allen further teaches wherein the item delivery system comprises the United States Postal Service (see Col. 5 lines 39-53). Although, Allen discloses a delivery system as set forth above; Examiner notes the recitation; wherein the item delivery system comprises the United

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States Postal Service constitutes intended use language and as such is afforded little patentable weight.

13. As per Claims 6, 18, 30 and 42, Allen in view of Anchor teaches the method, medium and system of claims 4 and 28 as described above. Allen further teaches wherein the second item comprises at least one of a mailpiece (see Col. 8 lines 19-24).

14. As per Claims 7, 19, 31 and 43, Allen in view of Anchor teaches the method, medium and system of claims 1, 25 and 37 as described above. Allen does not explicitly teach the limitation taught by Anchor wherein at least one of the plurality of address resolution processes includes sending the first item including the first instance of the incorrect address; the first item configured to be delivered in an item delivery system (see pg. 1 Para.2), to an element of the item delivery system that delivers in an area defined by a United States Postal Service ZIP code included in the first instance of the incorrect address; and (see pg. 1 para. 2) wherein the method further comprises at least one of verifying, validating or supplying information to be included in the correct address (see pg. 2 para. 8) It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Allen to further include the teachings of Anchor to maintain and update accurate address mailing lists.

15. As per Claims 8, 20, 32 and 44, Allen in view of Anchor teaches the method, medium and system of claims 1, 25 and 37 as described above. Allen does not explicitly teach the limitation taught by Anchor wherein at least one of the plurality of address resolution processes includes entering first instance of the incorrect address into a database to obtain a correct United States Postal Service ZIP+4 code to be

included in the correct address (see pg. 2 para. 8). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Allen to further include the teachings of Anchor to maintain and update accurate address mailing lists.

16. As per Claims 9, 21, 33 and 45, Allen in view of Anchor teaches the method, medium and system of claims 1, 25 and 37 as described above. Allen does not explicitly teach the limitation taught by Anchor wherein at least one of the plurality of address resolution processes includes modifying individual address components of the first instance of the incorrect address record to obtain a valid match to a database entry (see pg. 2 para. 8 and 10 and pg. 3 para. 5). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Allen to further include the teachings of Anchor to maintain and update accurate address mailing lists.

17. As per Claims 10, 22, 34 and 46, Allen in view of Anchor teaches the method, medium and system of claims 1, 25 and 37 as described above. Allen further teaches wherein at least one of receiving and outputting further comprises utilizing at least one of regular mail, e-mail, facsimile, internet, or an interactive voice response system (see Col. 4 lines 23-40).

18. As per Claims 11, 23, 35 and 47, Allen in view of Anchor teaches the method, medium and system of claims 1, 25 and 37 as described above. Allen further teaches wherein at least one of receiving and outputting further comprises communicating over a network (see Col. 4 lines 62-67, Examiner is interpreting a computer retrieval of information in a database as communication over a network).

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19. As per Claims 12, 24, 36 and 48, Allen teaches the method of claim 1 as described above. Allen further teaches wherein the incorrect address includes an incorrect United States Postal Service ZIP+4 code (see Col. 4 lines 23-26 and 30-36). Allen does not explicitly teach a second instance of the incorrect address nor comparison of a *second instance* of the incorrect address, however, this is merely a re-checking step of an address record for a mail item that was previously corrected. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.

20. As per Claim 49, Allen in view of Anchor teaches the method of claim 1 as described above. Although Allen does teach receiving an incorrect address (see Col. 4 lines 23-28), Allen does not explicitly teach receiving a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is the same as the "first instance" of an incorrect address of Claim 1, as taught by Anchor. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Allen and Anchor to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected. Furthermore a mere duplication of steps has no patentable significance unless anew an unexpected result is achieved.

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21. As per Claim 51, Allen in view of Anchor teaches the method of claim 13 as described above. Allen does not explicitly teach the limitation taught by Anchor wherein the first component receives an incorrect address (see pg. 2 para. 7). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Allen to include the teachings of Anchor to maintain correct address mailing lists. Allen does not explicitly teach receiving a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is the same as the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected. Furthermore a mere duplication of steps has no patentable significance unless anew an unexpected result is achieved.

22. As per Claim 53, Allen in view of Anchor teaches the medium of claim 25 as described above. Allen further teaches, wherein the instructions, when executed by a processor, further perform the stage of receiving of an incorrect address (see Col. 4 lines 23-28). Allen does not explicitly teach receiving a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is the same as the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second

instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected. Furthermore a mere duplication of steps has no patentable significance unless anew an unexpected result is achieved.

23. As per Claim 55, Allen in view of Anchor teaches the system of claim 37 as described above. Allen further teaches wherein the means for receiving receives an incorrect address (see Col. 4 lines 23-28). Allen does not explicitly teach receiving a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is the same as the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected.

24. Claims 50, 52, 54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. U.S. Patent No. 5,422,821 in view of Anchor (Reference U of the PTO-892) in further view of Cordery U.S. Patent No. 5,682,429.

25. As per Claims 50, 52, 54 and 56, Allen further teaches comparing the incorrect address to the stored resolved address (see Col. 15 lines 63-68 and Col. 16 lines 1-3); Allen does not explicitly teach the limitation taught by Cordery, resolving the incorrect address to determine a correct address using at least one of the plurality of address resolution processes when the incorrect address does not match the stored first instance of the incorrect address (see Col. 11 lines 11-27); and storing the incorrect address and the correct address a part of a resolved address in the database (see Col.

10 lines 27-41); It would have been prima facie obvious to one of ordinary skill at the time of invention to modify the method of Allen to include the teachings of Cordery to determine if an address was previously corrected, as taught by Cordery Col. 11 lines 20-29. Allen does not explicitly teach comparing, resolving or storing a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is tantamount to the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected. Furthermore, a mere re-arrangement of parts does not distinguish itself from the prior art unless a new and unexpected result is found.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TONYA JOSEPH whose telephone number is (571)270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628